

REMARKS

The most recent Office Action withdrew the previous rejection, but submitted new grounds of rejection. The Examiner is respectfully thanked for removing the rejection based on Bays.

The Office Action rejected claims 54, 56-65 and 67-71 under 35 U.S.C. Section 103 (a) as being unpatentable over Fritzsich 5,441,499 in view of Jandak et al. (6,176,858) and further in view of Gentelia (5,599,348). The Office Action also rejected claim 66 under 35 U.S.C. Section 103 (a) as being unpatentable over Fritzsich 5,441,499 in view of Jandak et al. (6,176,858) and Gentelia (5,599,348) and further in view of Swanson et al. 6,123,702.

Fritzsich discloses a bipolar radio-frequency surgical instrument for cutting tissue. The surgical device is designed for laparoscopic surgery. Fritzsich states this means that it must be insertable through a trocar to the site of the operation without any problems. Typical laparoscopic surgeries include at least two body access points. One access point typically includes a viewing system with a light and one access point typically includes a surgical device for affecting tissue. All other things being equal, it is preferred to keep the size of the incision for an access point as small as possible.

The Office Action proposes that it would be obvious to add the battery and light system of Jandak to Fritzsich. The Office Action further suggests that it would further be obvious to add the indicator light of Gentelia to the combination of Jandak and Fritzsich. Applicants respectfully disagree for several reasons.

The system of Fritzsich is designed for laparoscopic surgical procedures. The addition of a battery and light system would add bulk, weight and complexity to the ablation system of Fritzsich. This is inconsistent with the general desire in laparoscopic procedures to keep the incision length for trocar access to a minimum. One of ordinary skill in the art would not seek to add such a feature to the ablation system of Fritzsich as such a proposed addition would add to the bulk, weight or size of the system.

Fritzsche is a *cutting* ablation system. This is a relatively aggressive form of ablation when compared to other forms of ablation such as an ablation system only designed to kill tissue while preserving its structural integrity. A cutting device removes tissue and creates an environment that is very likely to fog or cloud optical instrumentation. One of ordinary skill in the art would not add a light that would only be quickly clouded or fogged by the cutting function of the device.

On multiple occasions, Fritzsche mentions problems associated with viewing during laparoscopic cutting procedures. These problems would not be solved by adding a light and battery system directly to Fritzsche. Instead, Fritzsche discloses a different solution to the viewing problem. As a result, Fritzsche teaches directly away from the proposed combination advocated by the Office Action.

The Office Action is silent with respect to how claim 71 reads on Fritzsche. Claim 71 calls for a limitation wherein "the rounded tip portion [is] free of any electrode movable relative to the rounded tip portion." Clearly Fritzsche does not disclose this limitation in combination with the remaining claim features and none of Jandak, Gentella or Swanson cure that deficiency. For this additional reason, claim 71 is allowable over the cited art.

Jandak discloses a transvessel system for performing transmyocardial revascularization or stimulating angiogenesis using a resistive heater. The transvascular system of Jandak operates very differently than the laparoscopic system of Fritzsche. This alone would lead one of ordinary skill in the art away from the combination of Jandak and Fritzsche as the differences in the operation of the two systems would not render the combination predictable.

There are other problems associated with the Fritzsche/Jandak et al. combination. Jandak et al. discloses a battery 108. However, the battery is connected to a heater element 28. In contrast, claim 54 sets forth "a light located on the medical device and electrically coupled to a power source...". Thus, such a combination still fails to teach the presently claimed invention.

Gentella et al. was also cited in the combination. Gentella discloses a trocar device incorporating an electrosurgical cutting element. The cutting element is used to

make a guide hole for the cannula and enables the remainder of the trocar assembly to enlarge the puncture. An electronic control circuit senses the current flow to the cutting element and, when the trocar device breaks through the wall of the organ being cut, this circuit cuts off the connection to the associated electrosurgical generator.

The Office Action referenced reference character 94 and column 5, line 64 — column 6 line 11 of Gentelia. This passage states:

In order to alert the surgeon to the fact that the reset delay period is being timed out, an intermediate stage of the counter of the reset delay counter circuit 86 is used to cause an indicator light or lamp (e.g. a LED) 94 to blink during the inhibit delay period. ... When the output of switch 90 is low, meaning that control relay 88 is actuated and the electrosurgical generator is turned on, LED 94 will also be continuously on to provide an indication to the surgeon that the generator is on. Further ... when the generator is off but the reset delay period is being timed out, the intermediate stage of the reset delay counter 86 will provide a pulsed signal to NOR gate 96 which will cause blinking of LED 94 during this period.

This is a very different circuit than the battery/heater circuit of Jandak. Because these circuits are so different, there is no indication that one of ordinary skill in the art would have any expectation of success in combining them. As a result, it is respectfully suggested that the combination of Fritzsche, Gentelia and Jandak is inappropriate to arrive at the present invention and it should be withdrawn.

Swanson does not cure the deficiencies of Fritzsche, Gentelia and Jandak. As a result, claim 66 is also allowable as well.

It is respectfully submitted that the pending claims are in condition for allowance.

No fee is believed due for this submission. Please charge any additional fees or credit any overpayment to Deposit Account No. 13-2546.

If the Examiner comes to believe that a telephone conversation may be useful in addressing any remaining open issues in this case, the Examiner is invited to contact the undersigned at 763-505-8426.

Respectfully submitted,

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By



Jeffrey W. Hohenshell, Reg. No. 34,109

Medtronic, Inc.

710 Medtronic Parkway

Minneapolis, MN 55432

Tel. 763-505-8426

Fax. 763-505-8436

Customer No.: 27581